

2 thereon instructions to said seller about how to post said information about said good on said  
3 website.

CZ 1 40. (new) A method according to claim 38, said physical sign being offered for sale at  
2 a retail store, said seller purchasing said sign at said retail store.

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#### REMARKS

Applicant's counsel thanks the Examiner for her very careful examination of the present application, and notes with appreciation the withdrawal of the finality of the prior Office action.

Claim 1 has been amended, claims 24-25 have been cancelled, and new claims 37-40 have been added to more clearly describe the invention. No new matter has been entered.

As amended, claim 1 now recites, inter alia,

- "said physical sign being provided for sale at a retail store,"
- "a seller of said good for sale or rent purchasing said physical sign from said retail store," and
- "after purchasing said physical sign, when said seller logs onto said website to post said information thereon," and the unique identifier is provided to or entered by the seller in connection with posting the information.

(See claim 1 as amended).

From claim 1, it is now clear that the seller of a good initiates an internet transaction for the sale (or rent) of that good by first purchasing the "for sale" sign at a retail store. After having purchased the "for sale" sign, the seller is led by the sign to the internet website where he can post the information about whatever it is he wishes to sell.

As amended, claim 1 has essentially incorporated limitations from claims 24 and 25 which have now been cancelled. In the Office action, the Examiner rejected claims 24 and 25 (now substantively incorporated into claim 1) under 35 USC § 103(a) as being allegedly obvious over FSBO in view of Berlin. In making this rejection, the Examiner recognized that "FSBO does not teach buying/selling physical signs in retail stores," Office action, ¶ 9, and instead relies on Berlin to supply this teaching. Specifically, the Examiner states

As per knowledge generally available there are many people who do not feel

comfortable in buying goods on-line due to a number of reasons and they would like to buy directly from the retail stores. Berlin expressly teaches many people who do not feel comfortable in buying goods on-line due to a number of reasons and they would like to buy directly from the retail stores (see at least col. 3, line 60-col. 4, line 14).

Office action, ¶ 9.

Following this line of reasoning, the Examiner further states that it would have been obvious to modify FSBO "to include the feature of selling signs at retail stores so that those people who do not feel comfortable in making purchases online can buy the signs in retail stores."

Respectfully, this rejection is traversed. First, it is respectfully submitted that FSBO cannot be permissibly combined with Berlin to sustain the Examiner's rejection. FSBO provides a real estate marketing website where real estate sellers can post information about their properties in the hopes that a purchaser will view their property and make an offer to purchase it. As an added marketing tool, the website provider also provides "custom yard signs" for sale over the internet to persons who have purchased an advertisement on the website. (See page 9 of FSBO). Conversely, and in stark contrast to FSBO, Berlin provides a method to securely pre-pay for digital information that is obtained via a computer network once the prepaid account identity and remaining balance are verified. (See whole specification, particularly abstract, Field of the Invention (col. 1) and SUMMARY OF THE INVENTION (cols. 4-5):

The present invention relates to a method and system for retrieving a selected type of information from a remote computer via a computer network in response to a prepayment. A user purchases a portable computer data storage medium device [disk token]...[which] is associated with a certain type of information and a certain number of pre-paid access units.... To receive information of the type for which the user has pre-paid, the user loads the disk token into a suitable data storage device [which then communicates with a central computer to retrieve the particularly pre-paid information in exchange for deducting pre-paid units from the disk token].

Col. 4 lines 17-65.

Thus, the two references (FSBO and Berlin) are from totally unrelated fields of art, and neither addresses or is concerned with methods addressed by the other. The motivation to combine references must come from the references themselves, or from the knowledge or skill of a person having ordinary skill in the art. Clearly, the motivation cannot have come from either of the references; FSBO is silent as to retail sign sales as the Examiner has recognized, and Berlin is drawn to a secure prepayment system for digital information and mentions

nothing with regard to the sale of tangible goods such as real estate.

Second, applying Berlin as the Examiner has done is totally inconsistent with the online real estate website of FSBO. The passage of Berlin cited by the Examiner provides: "Others may prefer shopping by conventional non-electronic methods, because they believe the likelihood of finding on the Internet the product or service they seek is small in relation to the time spent searching." Berlin, col. 4 lines 6-9. This is absolutely antithetical to FSBO because FSBO is exactly what Berlin says people would want to avoid, one of the very purposes for the invention of Berlin; i.e. FSBO is an online (electronic) marketplace or website for the posting and advertising of goods for sale. In order to come to the FSBO website, one must search the web, spending time searching that is significant compared to "the likelihood of finding on the internet the product" he/she seeks. Thus, Berlin and FSBO not only cannot be combined for lack of motivation, but they are inconsistent with one another; a person who seeks to avoid web browsing but wants to get predetermined, pre-paid electronic information in incremental units using a disk token (Berlin) certainly would not sit down to a computer terminal to browse the internet to find his next home (FSBO). In fact, the very browsing required in FSBO is expressly avoided in Berlin; "The user need not understand how to search the Internet because the user purchases a disk token that is associated only with the information of the type in which the user is interested." (Col. 5 lines 13-17).

Third, respectfully, even if FSBO and Berlin are combined as the Examiner suggests, the rejection misunderstands the thrust of the Applicant's claimed invention. The invention includes providing a physical "for sale" sign for sale at a retail outlet (e.g. Wal-Mart or Home Depot) that a person (seller) buys if he has something he wants to sell. This person, the seller, takes the sign home and, following the instructions, logs onto a website to post information that a potential purchaser can view by visiting the website listed on the sign. The seller then places the sign on the good for sale so that it is visible to passers-by (potential purchasers) who are then informed of the website to visit for more information.

The Examiner has cited as the motivation for combining Berlin with FSBO that persons may be uncomfortable with purchasing goods on the internet (see Examiner's language, quoted above). However, a person's comfort level with conducting an online transaction is not even at issue in the present invention. The invention is not merely to provide a sign at a retail store as an alternative to online, so that uncomfortable purchasers can feel more secure in tendering their credit cards. Rather, the invention is a method of marketing a

good online that is initiated by the seller when he/she purchases the physical sign. In other words, the physical sign leads the seller to the internet to post information about his good, and ultimately to an internet-facilitated transaction. This is the opposite of FSBO, where the internet website offers a physical sign to persons who have already signed up to advertise their homes on the website; i.e. in FSBO, the internet leads the seller to the physical sign.

Thus, it is clear in FSBO the sign is incidental to an internet-based advertising scheme where sellers must first browse the internet to discover the FSBO site, and then can purchase the yard sign as an optional extra. On the contrary, in claim 1 the physical sign is essential to the claimed marketing method because the sign and the internet each for part of an integrated marketing system where an internet-based transaction (the sale of the good) is initiated by the seller purchasing the physical sign without having to browse the internet to find the website.

In summary, the motivation cited by the Examiner to combine Berlin and FSBO (concern over providing credit card numbers online) is inconsistent and wholly irrelevant in FSBO and in the present invention, the references as applied are inconsistent with one another and therefore cannot support the Examiner's rejection, and the order of the steps in the present invention (sign is provided for sale at a retail store, seller purchases the physical sign, and then the seller logs onto the website to post information) are the opposite of FSBO and cannot be obvious thereover. Accordingly, it is respectfully submitted that claim 1 as amended is now allowable over the cited references.

New claim 38 is also an independent claim, and is believed to be allowable for the same reasons discussed above with respect to claim 1.

The Examiner has also rejected claim 9 under 35 USC §103(a) for obviousness over FSBO. In making the rejection, the Examiner recognizes that "FSBO does not disclose preprinting instructions on the sign." Office action page 6. Instead, the Examiner states it would be obvious to visit preprinted websites to get more information. Respectfully, it appears the Examiner has interpreted claim 9 to refer to instructions to a buyer interested in purchasing the advertised good. However, claim 9 refers to "instructions to said seller about how to post said information about said good on said website...." See claim 9. Accordingly, though it may be obvious to a buyer or potential purchaser to visit a preprinted website to "get more information" as the Examiner suggests, it is not obvious from FSBO to provide instructions to the seller preprinted on the sign (e.g. on the back side of the sign) regarding how the seller is to log onto the website, post the required information, and either enter or


obtain the unique identifier to correspond to the good he wishes to sell. Accordingly, it is respectfully submitted that the rejection of claim 9 has now been overcome.

In view of the above, it is believed that claims 1, 9 and 38 are now allowable over the cited references. All remaining claims are dependent claims and are thus also believed to be allowable. Thus, all claims now being in condition for allowance, early notice to that effect is respectfully requested.

If any fees are required by this communication which are not covered by an enclosed check, please charge such fees to our Deposit Account No. 16-0820, Order No. 32759US1.

Respectfully submitted,

PEARNE & GORDON LLP

By:   
Steven J. Solomon, Reg. No. 48719

526 Superior Avenue East, Suite 1200  
Cleveland, Ohio 44114  
(216) 579-1700

Date: April 7, 2003



**Marked Up Claims**  
**Serial No. 09/855,062**  
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1. (third amended) A method for marketing a good comprising the steps of:
- a) providing a physical sign, ~~said physical sign~~ having a preprinted website address, a space for a unique identifier, and an indication that a good is for sale or rent, said physical sign being provided for sale at a retail store,
  - b) a seller of a good for sale or rent purchasing said physical sign from said retail store,
  - b<sub>c</sub>) providing a website located at said website address, said website permitting ~~a~~ said seller to post on said website under said unique identifier information about said good, said website further permitting a prospective purchaser to enter said unique identifier in order to view said information,
  - ed) said seller conspicuously placing said sign physically on or adjacent said good for sale or rent, wherein said unique identifier corresponds specifically to said good on said website, and
  - de) wherein, after purchasing said physical sign, ~~when~~ said seller logs onto said website to post said information thereon, and said unique identifier is provided to said seller or entered by said seller at said website in connection with said seller posting said information on said website.